REMARKS

Claims 1 and 3-16 currently appear in this application. The Office Action of august 30, 2002, has been carefully studied. These claims define novel and unobvious subject matter under Sections 102 and 103 of 35 U.S.C., and therefore should be allowed. Applicants respectfully request favorable reconsideration, entry of the present amendment, and formal allowance of the claims.

Claim Objections

Claims 15 and 16 are objected to because of self-evident typographical errors. The present amendment corrects these errors.

Rejections under 35 U.S.C. 112

Clams 1, 3-7 and 10-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification is said not to provide enablement for "thawing without shearing."

This rejection is respectfully traversed. In the specification as filed at page 5, line 3 from the bottom to page 6, line 2, it is stated, "The frozen ground fish meat thus almost uniformly milled is then thawed by elevating temperature. The temperature may be elevated by using a heating means commonly employed in the art or by allowing to stand the milled ground fish

meat at room temperature." This clearly states that the fish meat is thawed without shearing the fish meat, *i.e.*, the thawing step is separate from the shearing step.

Additionally, in the process of Example 1, page 10, lines 19-23, the specification as filed states, "The granulated frozen ground Alaska Pollack meat was spread uniformly in a vat and spontaneously thawed by allowing to stand at room temperature (20 to 25°C) while occasionally stirring it to thereby achieve uniform temperature distribution." One skilled in the art would readily appreciate that this occasional stirring in the vat is not shearing.

The Examiner alleges that a "pin mixer" is the preferred type of mixer. However, it is respectfully submitted that this reference to a pin mixer is taken out of context. The specification as filed at page 7, lines 15-17, states, "To cope with this situation, it is preferable that the ground fish meat thawed by the method of the present invention is subjected to shio-zuri with the use of a pin mixer." Thus, it is quite clear that the "pin mixer" at [page 7, line 18, is preferred for use in the shio-zuri process, which is carried **after** the thawing process. While a pin mixer is the preferred mixer for the shio-zuri process, there is nothing in the

specification as filed that states that the pin mixer is preferably used in the thawing process.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is respectfully traversed. Claim 14 has been amended to delete "substantially."

Art Rejections

Claims 1, 3-6 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170 in view of Vitkovsky.

This rejection is respectfully traversed. There is nothing in the Canadian patent the discloses or suggests "thawing without shearing", and "-15°C below." The Canadian patent produces a finely milled product which is to be preserved in the frozen state. Because the finely milled product is to be preserved in the frozen state, there is no motivation to thaw the fish meat without shearing. Vitkovsky is concerned with preparing frozen free-flowing particles, and has nothing to do with thawing the frozen material. Just because Vitkovsky discloses milling frozen fish does not lead one skilled in the art to thaw fish meat without shearing, as claimed herein. In order to combine references to render

a claim obvious, there must be some motivation to combine the references to arrive at the claimed invention.

Claims 7 and 14-15 are rejected under 35 U.S.C. 103(A) as being unpatentable over CA 1213170 in view of Vitkovsky as applied above, and further in view of Katoh. Katoh is said to teach using a pin mixer to stir in additives.

This rejection is respectfully traversed. AS there is no motivation to combine CA 1213170 and Vitkovsky to arrive at the herein claimed invention, Katoh adds nothing to these two patents to render the claimed method obvious. Katoh merely states that fish paste can be processed using pin mixer. This adds nothing to CA and Vitkovsky to thaw frozen ground fish meat by milling the frozen ground fish meat to uniform particle size in the absence of partial thawing at -15°C or below, and then thawing without shearing the ground fish meat by elevating the temperature.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh in view of CA 1213170 and JP 06133793. Katoh et al. are said to teach a method of producing kamaboko by molding thawed, ground fish paste and heating the molded fish in two steps to induce gelling. The Examiner concedes that Katoh et al. do not teach milling frozen, ground fish meat or heating

with electricity. JP 06133739 is said to teach a method of producing molded fish paste products by heating with electricity.

This rejection is respectfully traversed. The Canadian patent is silent with respect to thawing ground fish meat without shearing the ground fish meat mass. Neither Katoh et al. nor the Japanese patent provides this missing information. Therefore, claims 8 and 9 are not obvious over the cited art.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al. in view of CA 1231179, JP 06133739 and Vitkovsky.

As discussed above, the combination of the Canadian patent and Vitkovsky do not teach or suggest the particular process claimed herein, namely, that frozen ground fish meat is milled to uniform particle size in the absence of partial thawing at -15°C or below, and then thawing without shearing. Without some disclosure in the prior art of this feature of the claim, there can be no finding of obviousness.

As the Federal Circuit stated in *In re Lee*, 61 USPQ2d 1430 (January 18, 2002, Fed. Cir.), "As applied to the determination of patentability *vel non*, when the issue is obviousness, 'it is fundamental that rejections under 35 U.S.C. 103 must be based on evidence

comprehended by the language of that section.' *In re Grasselli*, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000)… When patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness *See, e.g., McGinley v. Franklin Sports, Inc*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ('the central question is whether there is a reason to combine [the] references,' a question of fact drawing on the *Graham* factors."

'The factual inquiry whether to combine references must be thorough and searching.' *Id.* This precedent has been reinforced in myriad decisions, and cannot be dispensed with, *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). ('a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential component of an obviousness holding"') (quoting *C. R. Bard, Inc. v. M3 Systems, Inc.* 48 USPQ2d (Fed. Cir. 1998)) The Court went on to quote *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the

requirement for a showing of the teaching or motivation to combine prior art references."

There is a requirement for specificity in combining references, *See, In re Kotzab*, 55 USPQ2d 13134, 1317 (Fed. Cir. 2002)("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

In the present case, the Examiner has shown no motivation to combine the cited references to arrive at the particular invention claimed herein.

In view of the above, it is respectfully submitted that the claims are now in condition for allowance, and favorable action thereon is earnestly solicited.

Respectfully submitted,

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